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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,136	01/15/2002	Kwang Koo Jee	15220	4241

7590 04/24/2003

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

WYSZOMIERSKI, GEORGE P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 04/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/047,136

Applicant(s)

JEE, KWANG KOO

Examiner

George P Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 April 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner. See page 2.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the declaration as filed January 15, 2002 was filed in such condition that substantial portions thereof are illegible. A new oath or declaration is required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6-10, and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson et al. (U.S. Patent 4,758,285), in view of ether Sato (U.S. Patent 4,983,029) or Nakamura et al. (U.S. Patent 6,077,368).

Hodgson discloses an eyeglass temple piece, made of a nickel-titanium shape memory alloy, which is deformed in its martensitic state, then physically confined within a body of solid particles. The particles in the confined portion are then compacted, and this portion is heated to the austenitic temperature of the alloy so that the alloy can recover its shape. Hodgson differs from the claimed invention in that Hodgson uses the above-mentioned particles as a confining medium as opposed to the presently claimed "pipe", and the only particular portion of a pair of eyeglasses worked upon by Hodgson is a temple piece as opposed to the "lens rim" of the

instant claims. These differences are not seen as resulting in a patentable distinction between the prior art and the claimed invention because:

a) The temple piece of Hodgson can clearly be seen to comprise a long, thin piece; see Hodgson figure 3. Any confinement medium for such a piece would inevitably be pipe shaped, i.e. would surround this long, thin piece in such a manner that the confinement medium would, if looked at by itself, be in the shape of a pipe or tube. Further, Hodgson column 8, lines 32-36 indicates that mechanical restraints, such as clamps or sleeves may be used in the prior art process. Thus, no distinction is seen in this aspect of the invention.

b) The Sato and Nakamura patents indicate that it was well-known in the art, at the time of the invention, to employ nickel-titanium shape memory alloys as lens rims for eyeglasses, i.e. the same material as used by Hodgson.

Consequently, the disclosure of Hodgson et al., together with those of Sato or Nakamura et al., would have taught the presently claimed invention to a person having ordinary skill in the art.

4. Claims 4, 5, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodgson et al. in view of either Sato or Nakamura et al., as set forth supra, and further in view of Rossin (PG Pub. No. 2001/0028431).

The Hodgson process does not include the rolling or swaging steps as set forth in the instant claims. Paragraph [0022] of Rossin indicates the conventionality in the art of utilizing a rotary swaging process for the purpose of deforming nickel-titanium shape memory alloys which are to be used as eyeglass frames. Because of this conventionality, one of ordinary skill in the art would have been motivated to incorporate such a process into the process as disclosed by Hodgson et al. (again combined with the lens rim teaching of Sato or Nakamura et al.


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5. Rossin (U.S. Patent 6,511,174) and Krumme (U.S. Patent 6,523,952) are further cited of interest. The filing dates of these patents were subsequent to that of the present application.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (703) 308-2531. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (703) 308-1146. The fax phone number for this Group is (703) 872-9310 for all correspondence except for After Final amendments in which case the Fax number is (703) 872-9311. The Right fax number for this examiner is (703) 872-9039. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

GPW  
April 16, 2003

  
GEORGE WYSZOMIERSKI  
PRIMARY EXAMINER